

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Date: February 15, 2008
Erik Monsen et al.) Attorney Docket No.: F-709
Serial No.: 10/674,135) Customer No.: 00919
Filed: September 29, 2003) Group Art Unit: 3628
Confirmation No.: 2500) Examiner: Eric Liou
Title: METHOD FOR POSTAGE EVIDENCING FOR THE PAYMENT OF TERMINAL DUES	

APPELLANT'S BRIEF

Alexandria, VA 22313-1450

Sir:

 This brief is in furtherance of the Notice of Appeal filed in this case on December 18, 2007.

TABLE OF CONTENTS

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to Be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceeding Appendix

I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 10/732,152 entitled "Method For Indicating The Payment Of Customs Duties" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

- A) Claims 1 - 3, and 6 - 12 are in the application.
- B) Claims 4 and 5 have been cancelled.
- C) Claims 1 - 3, and 6 - 12 are rejected.
- D) Claims 1 - 3, and 6 - 12 are on appeal.

IV. Status of Amendments

No Amendment subsequent to the September 24, 2007, Final Rejection was entered.

V. Summary of Claimed Subject Matter

The invention makes it easier for the post offices to calculate terminal dues by obtaining fee information from mail that is sent internationally. The foregoing processes are accomplished by placing an indication on the mail that the fees for delivering the mail have been paid or will be paid by a mailer to each post office that handles the mail. For instance, if a mail piece is mailed in the United States and delivered to a destination in the United Kingdom, the mailer's postage meter will place a United States postal

indicia on the mail piece for that portion of the delivery cost that is attributable to the United States post office and a Royal Mail postal indicia on the mail piece for that portion of the delivery cost that is attributable to the Royal Mail. The United States postal indicia and the Royal Mail postal indicia may or may not include the proportional amount of postage charged in the United States and Royal Mail postal indicium. The amount of postage paid may be totaled or written in an encrypted or coded form.

Claim 1 is the only independent claim in this application. Claim 1 is a method for paying for mail to be delivered from a sender in a first country (23, Fig. 1) to a recipient in a second country (22, Fig. 1). The method comprises the steps of:

affixing a first indicia (20, Fig. 1) containing a unique number (19, Fig. 1) to mail (21, Fig. 1) for payment of carrier fees (24, Fig. 1) for the first country post office;

affixing a second country indicia (31, Fig. 1) containing a number (18, 32, Fig. 1) to the mail for payment of the carrier fees (17, Fig. 1) for a second country post office, and

debiting a meter (130, 131, Fig. 2) for the payment of the carrier fees (158, Fig. 3) for the first country post office and the carrier fees for the second country post office.

Appellant's invention is shown in paragraph 016 on page 4, paragraph 019 of page 5 to paragraph 028 of page 10 of Appellant's Specification. Claim 1 is also illustrated in Figs. 1A, 2 and 3.

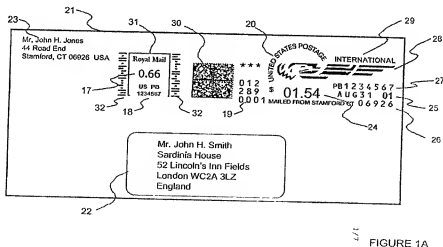


FIGURE 1A

[016] Referring now to the drawings in detail, and more particularly to Fig. 1A, the reference character 21 represents mail, i.e., letter, flat, package, that has a recipient

address field 22, a sender address field 23, United States postal indicia 20, and Royal Mail postal indicia 31. Indicia 20 includes the price for United States postage 24, the date 25 that indicia 20 was affixed to mail 21, the place 26 from which mail 21 was mailed, a postage meter number 27, an eagle 28, an international mail designation 29, a two-dimensional bar code 30, and a unique number 19. Royal Mail postal indicia 31 includes bar code 32, meter number 18, and the price of United Kingdom postage 17.

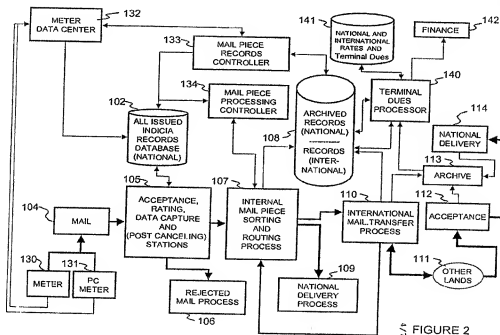


FIGURE 2

[019] Fig. 2 is a block diagram illustrating the process of metering international mail so that terminal dues will be paid. Electronic postage meter 130 or personal computer meter 131 may be used to print indicia 20 and 31, bar codes 30 and 31 and unique number 18 (Fig. 1). During a communication between postage meter 130 or personal computer meter 131 with data center 132, it will be indicated that meter 130 or meter 131 printed indicia 20 and 31, bar codes 30 and 31 and unique number 18. Meters 130 and/or 131 will also transmit all of the information contained in indicators 20 and 40 to data center 132. Data center 132 will transmit the information contained in indicia 20 and 31, bar codes 30 and 31 and unique number 18 to mail records controller 133. The operation of meters 130 and 131 will be described in the description of Fig. 3. Mail records controller 133 will transmit the information it receives from data center 132 to

data base 102, where a record is created specifically referenced to the issued unique number 18 for a particular meter 130 or 131 account number. The record is a proof of validity of postal indicia 20 and 31 having an issued unique number 18 for a particular meter, and the proof is provided when data base 102 is consulted.

[020] Postal terminal dues processor 140 is coupled to archive 108, national, international and terminal dues data base 141, finance 142 and archives 108 and 113. Processor 140 will poll archive 108 and archives 113 in other lands 111 (United Kingdom, France, German, Japan, etc.) and utilize data base 141 to determine the value of the mail processed by the receiving countries from the sending countries. Then processor 140 will determine how much money each country will receive for delivering mail 21. The amounts of money will be described in the description of Fig. 4. At agreed upon intervals, finance 142 will issue terminal dues statements to all participating countries and arrange for the transmission of funds to the countries' post offices.

[021] In step 104, the mail is collected and rated at various post office recording stations using data capture techniques and processed by the accepting post office in step 105. As part of the mail accepting procedures in step 105, indicia 20 and 31, bar codes 30 and 31 and unique number 19 are examined and compared to data in data base 102, to determine whether the indicia 20 and 31, bar codes 30 and 31 and unique number 19 used are legitimate. When unique number 19 is issued for postal indicia 20, and unique number 19 is issued for indicia 31, the issuance of unique numbers 18 and 19 are reported to the all issued indicia records national data base 102, where a record is created, specifically referenced to the issued unique numbers 18 and 19 for a particular mailer account number. The record is a proof of validity of postal indicia 20 and 31 having an issued unique number for a particular mailer account number, and the proof is provided when data base 102 is consulted.

[022] In the acceptance process, a code reader is used to identify the unique numbers 18 and 19 and account number on indica 20 and 31. It is understood that, if any portion of indicia 20 and 31, bar codes 30 and 31 and unique numbers 18 and 19 are produced with an invisible ink, a special light source will be needed to make the indicia 20 and 31,

bar codes 30 and 31 and unique number 18 visible to the code reader. The identified indicia 20 and 31, bar codes 30 and 31 and unique numbers 18 and 19 are reported to data base 102, and a proof of validity of indicia 20 and 31, bar codes 30 and 31 and unique number 18 is requested. If data base 102 has a record showing the issuance of the unique number 18 for the particular meter account serial number used and that the unique number 18 has not been canceled, then indicia 20 and 31 are considered legitimate. In that case, indicia 20 and 31 have passed the verification process, and the mail is accepted for further processing, with indicia 20 and 31 being canceled in step 105. It is preferred that the cancellation mark is produced with a visible ink in a manner that a "canceled" postal indicator is easily distinguishable from an unused one, and that a "cancelled" postal indicator" will still be able to be read.

[023] When indicia 20 and 31 bearing a unique number 19 for a particular user meter account serial number is canceled in step 105, a request is made to data base 102 to alter the record that is specifically related to the unique number 19 being canceled. The altered record will contain the date and time of cancellation, the cost of the selected services derived from the weighing of the mail, and no longer provide a proof of validity when data base 102 is consulted. The cost for mailing the mail determined in step 105 will be charged to the mailer's meter 130 or 131. The mailer cost information will be transmitted to data center 132 via data base 102 and controller 133.

[024] However, if the acceptance procedures in step 105 fail to yield a proof of validity of indicia 20 and 31, the mail will be sent to rejected mail process 106 where the mail will be returned to the sender or placed in the dead mail file.

[025] The mail that step 105 determines has legitimate indicia 20 and 31 is sent to step 107 for internal sorting and routing from place to place. Step 107 will note the date and time the mail is at each step in the process. The foregoing information will be sent to archive 108. Then the physical mail is delivered nationally in step 109 or delivered internationally in step 110. Nationally, at the recipient's delivery post office, the mail will be scanned during the last sorting process where the date and time of sorting as well as

next mail is not present, the next step will be step 162. Step 162 clears buffers 154A – 154E. If block 150 determines that the next mail is present, the next step will be step 151. Step 151 obtains all mail rating parameters from the operator of meters 130 or 131 and/or another external source, i.e., how much does the mail weigh, the size of the mail, where is the mail going, what is the level of mail service, the contents of the mail, etc., and places them in buffer 154A. Next, in step 153 the delivery location of the mail and the final carrier is obtained from the operator of meters 130 or 131 and/or another external source and stored in buffer 154A. Then in step 155 all desired special services are obtained from the operator of meters 130 or 131. The data from step 155 is stored in buffer 154A. In step 156 the correct route and fees are verified with data center 132, i.e., the information obtained from buffer 154A is verified with remote data center 132.

[028] Step 165 stores the valid mail route and fees file and any new bar codes and indicia graphics it receives from data center 132 and then transmits the valid mail route and fees file and indicia graphics to buffer 166. Step 157 reads the valid mail route and fees file in buffer 166. Step 158 takes the valid mail route and fees file and computes and buffers all fees, carrier bar codes plus required indicia and special service graphics with buffers 154B, 154C and 154D, i.e., the total fee for mail 20 (Fig. 1A) would be \$4.70 with \$2.20 payable to the Royal Mail and \$2.50 going to the United States Postal Service. It would be obvious to one skilled in the art that the payment to the Royal Mail may be made in United States Dollars or United Kingdom currency at the prevailing exchange rate. Step 159 composes the full indicia enroute, sequenced order and stores the above information in print buffer 154E. In step 160 the print image stored in buffer 154E is printed on mail 20, and then the image is sent to data center 132. The next step is performed by decision block 161. Decision block 161 determines whether or not the image has been printed on mail 20 and whether or not the image has been sent to data center 132. If the image has not been printed on mail 20 and the image has not been sent to data center 132, the process will go back to the input of decision block 161. If the image has been printed on mail 20 and the image has been sent to data center 132, buffers 154A – 154E and 166 will be cleared and the next step will be performed by decision block 150.

VI. Grounds of Rejection to be Reviewed on Appeal

A. Whether or not claims 1-3, 6 – 7 and 12 are patentable under 35 U.S.C. § 103(a) over Schwartz et al., U.S. Publication No. 2002/0073040.

B. Whether or not claims 8 – 10 are patentable under 35 U.S.C. § 103(a) over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov. U.S. Patent No. 6,125,357.

C. Whether or not claim 11 is patentable under 35 U.S.C. § 103(a) over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov. U.S. Patent No. 6,125,357 and further in view of Sansone U.S. Patent 6,125,357.

VII. Argument

A. Claims 1-3, 6 – 7 and 12 have been rejected by the Examiner under 35 USC § 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040.

Claims 1, 6, 7 and 12

Schwartz discloses the following in paragraphs 0059 to 0062:

"[0059] FIG. 7 illustrates postage indicium 700 in accordance with the invention. As shown in FIG. 7, indicium 700 includes human readable portion 705 and bar-code portion 710. Unlike portion 605 of FIG. 6, portion 705 includes human readable transactional data 708 indicating a payment (e.g., \$10.00 to a specified payee (e.g., XYZ Co.). As described herein below, like postage 709 (e.g., \$0.32), the payment amount (i.e., \$10.00) was deducted from the available funds in the descending register in card 180 when indicium 700 was created. Thus, the originator of indicium 700 in this instance expended \$10.00 additional postage (i.e., in addition to the \$0.32 postage for the cost of delivery of the mail piece on which indicium 700 is applied) in favor of the postal authority. This additional expended amount is to be paid by the postal authority to the payee in a manner to be described.

[0060] Moreover, unlike bar-code portion 610 representing the required postal data and digital signature, portion 710 additionally includes transactional data. However, like portion 610, the data in portion 710 is readable by the postal authority when it uses a conventional bar-code scanner to process the indicium. In accordance with the invention, after learning the transactional data

in portion 710, the postal authority pays the specified amount to the payee.

[0061] FIG. 8 illustrates different data fields in bar-code portion 710. In particular, Fields 801a through 801g contain the transactional data in accordance with the invention.

Specifically, field 801a contains data identifying the payer and particularly data identifying the payer account with the payee for proper credit of the payment. For example, the payee, XYZ Co., in this instance is a credit card company.

The payer is a credit card holder who originated indicium 700 to pay his/her credit card balance (e.g., \$10.00) in accordance with the invention. Thus, in this example, the data in field 801a is most likely the payer's credit card account number.

[0062] Field 801b contains data identifying the payee, and the payee's bank account if a transfer of funds (in this instance in the amount of the credit card balance) by the postal authority to the payee is anticipated to realize the bill payment. In this instance, the data in field 801b represents the name of the payee and an EFT routing number identifying the payee's bank account."

Schwartz indicium 700 includes a human readable portion 705 and bar code portion 710. Human readable portion 705 includes a postage payment of \$0.32 represented by character 709 and a payment of \$10.00 to XYZ Co. represented by character 708. The data in portion 710 includes transactional data that is readable by the postal authority.

When the postal authority reads the data in portion 710 it recognizes that at least a part of portion 710 represents money that is due XYZ Co.

The Examiner stated in page 4 of the final Rejection the following:

"Thus the Examiner interprets bar code 710 to be a second country indicia."

Bar code 710 is a two Dimensional Bar Code that is a portion of Schwartz indicium 700. Indicium 700 is an example of an indicia of a first country i.e. the United States Postal Service (USPS) Indicia.

See the indicium (Digital Postage Mark) appearing in the USPS web site at <http://www.usps.com/postagesolutions/abotibip.htm>.

A copy of which reads as follows.

USPS - Digital Post Mark

Page 1 of 1



Home

Introduction
PC Postage™
Postage Meters
▶ About Postage
Related Services
Industry News
FAQ

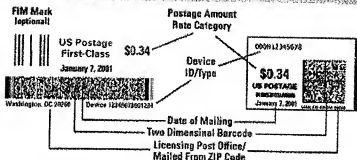
▶ Postage Solutions *About Postage Technology*

The Business of Turning Technology To Solutions.

The Business. Working with technology providers and product developers, our mission is innovative solutions that better serve customers. The I Service provides oversight through evaluation and authorization of the products and services.

The Technology. A new direction with an improved security baseline, new product offerings was launched with the Information Based Indicia (IBI). IBI is the new look in digital postage. An illustration is shown below.

The Indicia (Digital Postage Mark)



For more on this program:

- ▶ [Federal Register Notices](#) - Program and Policy notifications
- ▶ [Program Documentation](#) - Product Submission Procedures and C
- ▶ [Postal Bulletins](#) - Latest information on IBI and postage products



POSTAL
INSPECTORS
Preserving the Trust

[site map](#) | [contact us](#) | [jobs](#) | [national & premier accounts](#)

Copyright © 1999-2007 USPS. All Rights Reserved. [Terms of Use](#) [Privacy Policy](#)

Thus Schwartz only discloses one country's indicia namely a USPS indicia.

The Examiner indicating the following in pages 4 and 5 of the Final Rejection.

"10. The Examiner notes, Schwartz discloses a country post office (Schwartz: Figure 7, "705", "US Postage"; paragraph 0059). Schwartz does not disclose a second country post office. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included a second country post, office as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry."

The Examiner is incorrect in the above assumption. While it is true that a country post office is one carrier that the customer can select. The country post office selects the other carrier.

For instance if a mailpiece is posted with the United States Postal Service (USPS) for delivery to a destination in the United Kingdom, the USPS will select the Royal Mail to deliver the mailpiece in the United Kingdom and only a U.S. PostageStamp or a U.S. Postal Indicia will appear on the mailpiece. The customer or mailer may not select the post office in the second country.

Thus, Schwartz does not disclose a first country indicia containing a unique number for the payment of carrier fees for a first country post office and a second country indicia containing a number for the payment of carrier fees for a second country post office, as claimed in claim 1.

The Examiner stated the following in pages 5 and 6 of the Final Rejection.

"14. As per claim 6, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1; paragraphs 0008; 0023). Schwartz further discloses the use of postage meters to print postage indicia on mail pieces (Schwartz: paragraph 0007). Schwartz does not disclose the indicia are affixed to mail by a postage meter in the secure postage payment method.

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included indicia are affixed to mail by a postage meter as disclosed by Schwartz because the postage meter is an effective machine used in the industry to meter mail."

"[0008] In accordance with the invention, a postage payment system incorporating a general purpose computer is capable of securely dispensing postage, and efficiently generating mail pieces. In particular, with the inventive postage payment system, postage indicia are advantageously generated at the same time as mail contents such as letters, invoices, and statements. In accordance with an aspect of the invention, a postage indicium is applied onto a selected location of the mail content. In the preferred embodiment, the mail content is placed into a window envelope such that the postage indicium on the mail content exposes through a window of the envelope to facilitate inspection of the indicium.

[0023] FIG. 1 illustrates postage payment system 100 embodying the principles of the invention. As shown in FIG. 1, system 100 comprises computer 103 (e.g., a standard PC or workstation), mail processor 150, integrated circuit (IC) card 180, and printer 190 (e.g., a standard inkjet or laser printer). In particular, installed on computer 103 is a mailing application program in accordance with the invention. Also installed on the computer is conventional word processor, billing, accounting and/or other software which, among other things, enables a user to generate mail contents in text and graphics. Computer 103 is connected to mail processor 150.

Schwartz discloses the printing of one postal indicium. Schwartz does not disclose or anticipate the printing of a first country postal indicium and a second country postal indicium with a postage meter as claimed.

Claims 2 and 3

Claims 2 and 3 depend on claim 1. In claim 2 the first indicia is a post office postal indicia and in claim 3. the second indicia is a post office postal indicia.

The Examiner stated the following in page 5 of the Final Rejection.

11. As per claim 2, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses wherein the first indicia is a post office postal indicia (Schwartz: Figure 7, "705"; paragraph 0059).

12. As per claim 3, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses a post office postal indicia (Schwartz: Figure 7, "705"; paragraph 0059). Schwartz does not disclose the second indicia is a post office postal indicia.

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included the second indicia is a post office postal indicia as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry.

In addition to the arguments made above, please consider the following. Paragraph 0059 and Fig. 7 of Schwartz has been discussed above.

Schwartz only discloses a postal indicia for one country. The statement made by the Examiner above in paragraph 13 is clearly erroneous. A customer does not have the right to select a first country postal indicia for the payment of carrier fees for the first country post office and select; a second country postal indicia for the payment of carrier fees for the second country post office.

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

B. Claims 8 - 10 have been rejected by the Examiner under 35 USC § 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov. U.S. Patent No. 6,125,357.

Claims 8 and 10

Claim 8 depends on claim 1. Claim 8 adds the following steps to claim 1:

storing information contained in the first indicia and the second indicia in a database;

examining the first indicia information and the second indicia information; and

comparing the information stored in the database with the information examined to determine whether the first indicia, and the second indicia affixed to examined mail are legitimate.

In addition to the arguments made above, please consider the following.

The Examiner stated the following in pages 6 and 7 of the Final Rejection.

19. **As per claim 8**, Schwartz discloses the method of claim 1 as described above, Schwartz further discloses information contained in the first indicia and the second indicia (Schwartz: paragraphs 0059-0069); examining the first indicia information and the second indicia information (Schwartz: paragraph 0070); determining whether the first indicia, and the second indicia affixed to examined mail are legitimate (Schwartz: paragraph 0070; The Examiner notes, Schwartz discloses the step of verifying indicia (bar code 710). Schwartz does not disclose verifying human readable indicia 705 (first indicia). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included verifying human readable indicia 705 for the advantage of ensuring that postal data is correct prior to mailing a mail piece.).

20. Schwartz does not disclose storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate.

21. Pintsov discloses storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate (Pintsov: col. 8, lines 18-43).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate as disclosed by Pintsov for the advantage of identifying any mail that 'may be fraudulent.'

Pintsov discloses the following in col. 8, lines 18-43.

"In a first method verification is performed by verifying the local digital tokens and checking the identifications numbers for duplicates. Using this method, a postal administration may automatically verify the local tokens produced with the postally controlled secret key(s) and thus assure the integrity of the indicium data, but not the address data. If the database of the processed indicium ID number is available, the postal administration can then detect duplicates without looking at the address block. This is a traditional verification method.

FIG. 3 illustrates a flowchart of this verification process. At 50, the indicium is scanned. At 52, the indicium scan is verified using the error detection/correction code 40. At 54, local digital tokens are

computed using indicium information from indicium lines 14 and 16. At 56, the local digital tokens are compared to indicium local digital tokens 32, 34 and 36. At 58, a query is made as to whether the local digital tokens match the indicium local digital tokens. If the local digital tokens do not match, then the suspected fraudulent mail piece is investigated at 60. If the verification process is successful, at 62, the mail piece identification and device identification numbers are compared to identification numbers in a database of identification numbers. At 64, the query is made as to whether the verification is successful. If the verification is not successful, the suspect fraudulent mail piece is investigated at 60. If the verification is successful, the mail piece is delivered at 66."

Pintsov compares the local digital tokens to the indicium digital tokens to verify the indium.

Schwartz and/or Pintsov taken separately or together do not disclose or anticipate examining the first indicia information and the second indicia information: and comparing the information stored in the database with the information examined to determine whether the first indicia and the second indicia affixed to examined mail are legitimate as claimed in claim 8.

Claim 9

Claim 9 depends on claim 8, which depends on claim 1. Claim 9 adds the following steps to claim 8: utilizing the unique number contained in the first indicia and the number contained in the second indicia to determine whether the first indicia and the second indicia affixed to the examined mail are legitimate.

In addition to the arguments made above, please consider the following.
The Examiner stated the following in pages 7 and 8 of the Final Rejection.

23. **As per claim 9**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses the unique number contained in the first

indicia and the number contained in the second indicia as described above. Schwartz does not disclose utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate.

24. Pintsov discloses utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate (Pintsov: col. 8, lines 18-43).

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz in view of Pintsov to have included utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate as disclosed by Pintsov for the advantage of identifying any mail that may be fraudulent.

Pintsov col. 8, lines 18 – 43 have been set forth above.

Pintsov compares the local digital tokens to the indicium digital tokens to verify the indium.

Schwartz and/or Pintsov taken separately or together do not disclose or anticipate utilizing the unique number contained in the first indicia and utilizing the unique number contained second indicia and comparing the information stored in the database with the information examined to determine whether the first indicia, and the second indicia affixed to examined mail are legitimate as claimed in claim 9.

C. Claim 11 has been rejected by the Examiner under 35 USC § 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov. U.S. Patent No. 6,125,357 and further in view of Sansone U.S. Patent 6,125,357.

Claim 11 depends on claim 8, which depends on claim 1. Claim 11 adds the following steps to claim 8: marking the first indicia and the second indicia with a visible ink to distinguish a used first and second indicia from an unused first and second indicia.

In addition to the arguments made above, please consider the following.
The Examiner stated the following in pages 6 and 7 of the Final Rejection.

28. **As per claim 11**, Schwartz in view of Pintsov discloses the method of claim as described above. Schwartz further discloses the first and second indicia as described above. Schwartz in view of Pintsov does not disclose marking the indicia with a visible ink to distinguish a used indicia from an unused indicia.

29. Sansone discloses marking the indicia with a visible ink to distinguish a used indicia from an unused indicia (Sansone: Figure 7c; col. 7, lines 22-24).

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz in view of Pintsov to have included marking the indicia with a visible ink to distinguish a used indicia from an unused indicia as disclosed by Sansone for the advantage of providing a clear indicator that an indicia is cancelled.

Sansone discloses the following in lines 22-24 of col. 7.

"FIG. 7c illustrates a "canceled" indicium. As shown, a cancellation mark 146 is produced to deface the FIM symbol, rendering the indicium nonusable."

Sansone only discloses canceling one indicium, wherein applicant cancels two indicia.

PRAYER FOR RELIEF

Appellants' respectfully submit that appealed claims 1 - 3, and 6 - 12 in this application are patentable. It is requested that the Board of Appeal overrule the Examiner and direct allowance of the rejected claims.

Respectfully submitted,

/Ronald Reichman/
Ronald Reichman
Reg. No. 26,796
Attorney of Record
Telephone (203) 924-3854

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000

VIII. CLAIMS APPENDIX

1. A method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, comprising the steps of:

affixing a first indicia containing a unique number to mail for payment of carrier fees for the first country post office;

affixing a second country indicia containing a number to the mail for payment of the carrier fees for a second country post office, and

debiting a meter for the payment of the carrier fees for the first country post office and the carrier fees for the second country post office.

2. The method claimed in claim 1, wherein the first indicia is a post office postal indicia.

3. The method claimed in claim 1, wherein the second indicia is a post office postal indicia.

6. The method claimed in claim 1, wherein the first and second indicia are affixed to mail by a postage meter.

7. The method claimed in claim 1, wherein the first and second indicia are affixed to mail by a personal computer meter.

8. The method claimed in claim 1, further including the steps of:

storing information contained in the first indicia and the second indicia in a database;

examining the first indicia information and the second indicia information; and

comparing the information stored in the database with the information examined to determine whether the first indicia, and the second indicia affixed to examined mail are legitimate.

9. The method claimed in claim 8, further including the step of:
utilizing the unique number contained in the first indicia and the number contained in the second indicia to determine whether the first indicia and the second indicia affixed to the examined mail are legitimate.

10. The method claimed in claim 8, further including the step of:
canceling the first indicia and the second indicia.

11. The method claimed in claim 8, further including the step of:
marking the first indicia and the second indicia with a visible ink to distinguish a used first and second indicia from an unused first and second indicia.

12. The method claimed in claim 1, further including the step of:
reporting the payment of carrier fees for affixing the first indicia to the first country post office: and
reporting the payment of carrier fees for affixing the second indicia to the second country post office.

IX. EVIDENCE APPENDIX

There is no additional evidence to submit.

X. RELATED PROCEEDING APPENDIX

An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 10/732,152 entitled " Method For Indicating The Payment Of Customs Duties" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.